

REMARKS

In response to the non-final Office Action of October 6, 2008, applicants ask that all claims be allowed in view of the amendment to the claims and the following remarks. Claims 1, 7, 8, 14, 16, 20, 21, 38-43 and 55-81 are pending in this application, with claims 1, 14, 67, 72, 76, and 77 being independent.

Claim Rejections Under 35 U.S.C. § 101

Claims 1, 7-8, 55-60, and 67-75 have been rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. On the recommendation of the Examiner, applicants have amended claims 1, 7-8, 55-60, and 67-75 to recite a “computer-readable storage medium.” Applicants submit that, as amended, claims 1, 7-8, 55-60, and 67-75 recite statutory subject matter. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 1, 7-8, 55-60, and 67-75.

Claim Rejections Under 35 U.S.C. § 103

Independent claims 1, 14, 67, and 72 and their dependent claims 16, 20, 42, 55-57, 60-64, 70-71, and 73, have been rejected as being unpatentable over Doss (U.S. Patent Application Publication No. 2003/0046296) in view of Begole (U.S. Patent Application Publication No. 2004/0039630) and Imamura (U.S. Patent Application Publication No. 2002/0091774). Dependent claims 7, 8, and 21, which depend from claims 1 and 14, have been rejected as being unpatentable over Doss in view of Begole, Imamura and Widger (U.S. Patent Application Publication No. 2005/0117733). Dependent claims 38, 43, 65, and 66, which depend from claim 14, have been rejected as being unpatentable over Doss in view of Begole, Imamura and Lee (U.S. Patent Application Publication No. 2003/0233265). Dependent claims 39-41, 58-59, 68-69, and 74-75, which depend from claims 14, 67 and 72, have been rejected as being unpatentable over Doss in view of Begole, Imamura and Nielsen (U.S. Patent No. 6,108,688). Independent claim 76 has been rejected as unpatentable over Dos in view of Nielsen and Imamura. Independent claim 77 and dependent claims 78-79 which depend from claim 77, have

been rejected as being unpatentable over Doss in view of Imamura. Dependent claims 80-81, which depend from claim 77, have been rejected as being unpatentable over Doss in view of Imamura and Nielsen.

Independent claim 1, as amended, recites, among other features, a computer-readable storage medium having embodied thereon a computer program that includes instructions that cause a computer to determine a number of unread e-mail messages exchanged between the user and a first one of the co-users; and conditioned on the number of unread e-mail messages being greater than zero, display, within the window that includes the contacts list and in association with the identifier corresponding to the first co-user, a first graphical element that indicates that one or more unread e-mail messages have been exchanged between the user and the first co-user. The computer readable medium further includes instructions embodied thereon to cause a computer to enable the user to select the first graphical element, receive a selection of the first graphical element by the user, and in response to the selection of the first graphical element by the user, display to the user the number of unread e-mail messages exchanged between the user and the first co-user. Independent claims 67 and 72 recite limitations similar to those of independent claim 1. Independent claims 14, 76, and 77 recite limitations similar to those of independent claim 1 but in the context of a method. Applicants request reconsideration and withdrawal of the rejection of claims 1, 14, 67, 72, 76, and 77, and their dependent claims, because neither Doss, Begole, Imamura, Widger, Lee, Nielsen, nor any proper combination of the six describes or suggests the recited conditionally displaying, within the recited window and in association with an identifier corresponding to a co-user of an instant messaging system displayed in a contacts list in the window, a first graphical element that indicates that one or more unread e-mail messages have been exchanged between the user and the co-user, the first graphical element being selectable by the user to display to the user the number of unread e-mail messages exchanged between the user and the co-user.

The Examiner relies on Imamura for disclosing the features related to the display of a graphical element in the recited window that reflects e-mail exchanges between a user and a first co-user that when selected, displays to the user the number of unread e-mail messages exchanged

between the user and the first co-user. Imamura, however, fails to disclose these features. In particular, Imamura teaches a graphical user interface for a computer that is shared between multiple different users. The interface includes a login interface that displays a list of user identifiers. Each user identifier in the list identifies one of the multiple users that uses the computer. The list further includes a numeral displayed next to each user identifier that displays the total number of unread e-mail messages that the corresponding user currently has. If a user selects a user identifier (aka, the user's name) in the displayed list, the user is prompted to input a password to log into the computer under the associated user identifier. Upon successful entry of the password, the user is presented with an e-mail application interface that allows the user to access the corresponding unread e-mail.

The user identifiers and numerals referred to by the Examiner can not be considered to convey the same information as the graphical element as recited in the claims. The Examiner equates the numeral displayed next to each user identifier in Imamura's login interface with the recited graphical element that indicates that one or more unread e-mail messages have been exchanged between a user (i.e., the user perceiving the list having the graphical elements) and a first co-user (i.e., the user identified by the user identifier positioned next to the graphical element in the list). The numeral of Imamura, however, does not indicate that one or more unread e-mails have been exchanged between the user that is perceiving Imamura's list in the login interface and the user that corresponds to the user identifier displayed next to the numeral in the list. Rather, the numeral of Imamura merely indicates that the user corresponding to the user identifier displayed next to the numeral has unread e-mails from various senders, which leaves the viewer unaware of how many messages have been exchanged with the user with which the Imamura icon is associated. Imamura does not describe or suggest a graphical element that indicates that one or more unread e-mail messages have been exchanged between the user perceiving the list of names and the user that corresponds to the user identifier displayed in the list of names.

Moreover, Imamura's numeral cannot be selected by the user perceiving the list to thereby perceive the number of unread e-mails that have been exchanged between the user

perceiving the list and the user corresponding to the user identifier displayed next to Imamura's numeral. Rather, Imamura teaches that the user identifier (aka, name) displayed next to each numeral can "serve as a user-selectable icon." (*para 53*) Selection of the user identifier (not the numeral) in Imamura results in the user being prompted to input a password for logging into the computer under the identity corresponding to the selected user identifier. Upon successful entry of the password, the user is presented with an e-mail application interface that allows the user to access their unread e-mail. The numeral of Imamura, which indicates that the user corresponding to the user identifier displayed next to the numeral has unread e-mails from various senders, is not described as being selectable.

Additionally, Imamura's numeral is not displayed conditioned on the number of unread e-mail messages being greater than zero as recited in the claims. In fact, Imamura teaches that the numeral representing the number of unread e-mail messages addressed to a respective user is displayed next to the user identifier for the user even when the number of unread e-mail messages is equal to zero. (*para 53*)

Doss, Begole, Widger, Lee, and Nielsen, alone or in combination, fail to remedy the failure of Imamura to describe or suggest displaying the above-recited first graphical element that reflects e-mail exchanges between a user and a first co-user that when selected, displays to the user the number of unread e-mail messages exchanged between the user and the first co-user.

For at least these reasons, applicants request reconsideration and withdrawal of the rejection of claims 1, 14, 67, 72, 76, and 77, and their dependent claims.

Applicants submit that all claims are in condition for allowance.

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It is believed that no additional fees are required at this time. The Director is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account No. 06-1050. The Director also is hereby authorized to apply any additional fees or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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